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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/813,219 | 03/30/2004 | Tatsuhito Mutoh | O11.2-11521-US01 | 3864 |

490 7590 11/23/2005

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| EXAMINER |
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MARCHESCHI, MICHAEL A

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| ART UNIT | PAPER NUMBER |
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1755

DATE MAILED: 11/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/813,219

Applicant(s)

MUTOH ET AL.

Examiner

Michael A. Marcheschi

Art Unit

1755

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☒ Claim(s) 19 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim 19 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The use of the composition does not further define the composition in terms of its compositional makeup.

Claims 1, 2, 6-10, 13-14 and 19-20 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over GB 2,371,555 for the same reasons set forth in the previous office action which are incorporated herein by reference. **The rejection of claim 4 has been withdrawn from the above rejection because after further review, the reference does not teach a trial.**

Claims 5, 11, 12, 16-17 are rejected under 35 U.S.C. 103(a) as obvious over GB 2,371,555 in view Shemo et al. for the same reasons set forth in the previous office action which are incorporated herein by reference.

Claim 15 is rejected under 35 U.S.C. 103(a) as obvious over GB 2,371,555 in view Ide et al. for the same reasons set forth in the previous office action which are incorporated herein by reference.

Art Unit: 1755

Claim 18 is rejected under 35 U.S.C. 103(a) as obvious over GB 2,371,555 in view Shemo et al. and/or Miyata for the same reasons set forth in the previous office action which are incorporated herein by reference.

Claims 1-4 and 19-20 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Orii et al.

The reference teaches in column 4, line 66-column 6, line 40 and column 7, lines 40-55, a polishing composition for polishing a substrate (magnetic heads-i.e. encompasses magnetic disks) comprising a polyoxyethylene polyoxypropylene triol (i.e. glycerin reaction product) or other polyoxyethylene polyoxypropylene product having a defined molecular weight (present in the claimed amount), an abrasive (at least one selected from alumina, silica, etc.), an acid salt and a dispersion medium (water is implied, although not preferred). Amounts for the components are defined.

The claimed invention is anticipated by the reference because the reference teaches a composition which comprises all of the claimed components. The recitation of a polyoxyethylene polyoxypropylene triol or other polyoxyethylene polyoxypropylene triol having a defined molecular weight broadly reads on the claimed reaction product because all of the materials of the reference product are present in the claimed reaction product absent evidence to the contrary. In the alternative, no patentable distinction is seen to exist between the reference and the claimed invention absent evidence to the contrary because it is the examiners position that the triol or other product of the reference encompasses the claimed reaction product and therefore **A generic disclosure renders a claimed species prima facie obvious. *Ex parte***

Art Unit: 1755

***George* 21 USPQ 2d 1057, 1060 (BPAI 1991); *In re Woodruff* 16 USPQ 2d 1934; *Merk & Co. v. Biocraft Lab. Inc.* 10 USPQ 2d 1843 (Fed. Cir. 1983); *In re Susi* 169 USPQ 423 (CCPA 1971).**

Claims 5-8, 10, 13 and 14 are rejected under 35 U.S.C. 103(a) as obvious over Orii et al.

Although the reference does not literally teach the kinematic viscosity of instant claim 5, this is obvious because the claimed material appears to be the same as the triol or other product and the same material, which also has the same molecular weight, is expected (i.e. obvious) to have the same viscosity absent evidence to the contrary.

With respect to claims 6 and 10, the reference teaches amounts which encompass the claimed amounts.

With respect to claim 8, the reference teaches an amount of abrasive modified by “about” and about permits some tolerance, *In re Ayers*, 154 F 2d 182, 69 USPQ 109.

With respect to claim 7, the reference uses alumina and the alpha form is broadly encompassed by this because a **generic disclosure (of alumina) renders a claimed species (alumina form) prima facie obvious.** ***Ex parte George* 21 USPQ 2d 1057, 1060 (BPAI 1991); *In re Woodruff* 16 USPQ 2d 1934; *Merk & Co. v. Biocraft Lab. Inc.* 10 USPQ 2d 1843 (Fed. Cir. 1983); *In re Susi* 169 USPQ 423 (CCPA 1971).**

With respect to claim 13, the combination of abrasives is clearly within the scope of the skilled artisan because it is prima facie obvious to combine two or more materials disclosed by the prior art to form a third material (combination of abrasives) that is to be used for the same purpose. *In re Kerkhoven* 205 USPQ 1069.

Art Unit: 1755

With respect to claim 14, the combination being obvious, the reference clearly teaches a size for the abrasive and this size broadly reads on a colloidal sized material, thus making the colloidal abrasive obvious.

Claim 18 is rejected under 35 U.S.C. 103(a) as obvious over Orii et al. in view Shemo et al. and/or Miyata.

The pH of a polishing composition is dependent on the type of substrate to be polished. Although the primary reference fails to teach the pH, it is the examiners position that the claimed pH values are obvious because these pH values are known for polishing composition for magnetic disk substrates (i.e. a magnetic head can broadly be considered to be a magnetic disk) and the pH is dependent on the substrate.

Applicant's arguments with respect to claims 1-20 have been considered but are moot in view of the new ground(s) of rejection.

Although a new grounds of rejection has been applied, the examiner will comments on the GB reference.

Applicants argue that the GB reference does not teach a reaction product formed from the claimed materials. Applicants appear to be relying on process limitations (how the product is formed (i.e. by reaction between the specified components) and as is well established, process limitations used to define the product in "product-by-process" claims do not patentably distinguish the product even though made by a different process. *In re Thorpe* 227 USPQ 964. In addition, it is the examiners position that either (1) the copolymer or (2) the alkyl ether reads

Art Unit: 1755

on the material used, irrespective of how it was made or the reaction used to produce it. Finally, applicants provide no convincing evidence that the claimed **final** material is distinct from the material used in the prior art. A mere statement without supporting facts is insufficient to establish patentability.

In view of the teachings as set forth above, it is the examiners position that the references reasonably teach or suggest the limitations of the rejected claims.

A reference is good not only for what it teaches but also for what one of ordinary skill might reasonably infer from the teachings. *In re Opprecht* 12 USPQ 2d 1235, 1236 (CAFC 1989); *In re Bode* USPQ 12; *In re Lamberti* 192 USPQ 278; *In re Bozek* 163 USPQ 545, 549 (CCPA 1969); *In re Van Mater* 144 USPQ 421; *In re Jacoby* 135 USPQ 317; *In re LeGrice* 133 USPQ 365; *In re Preda* 159 USPQ 342 (CCPA 1968). In addition, "A reference can be used for all it realistically teaches and is not limited to the disclosure in its preferred embodiments" See *In re Van Marter*, 144 USPQ 421.

The subject matter as a whole would have been obvious to one having ordinary skill in the art at the time the invention was made to have selected the overlapping portion of the range disclosed by the reference because overlapping ranges have been held to be a prima facie case of obviousness, see *In re Malagari*, 182 U.S.P.Q. 549; *In re Wertheim* 191 USPQ 90 (CCPA 1976).

Evidence of unexpected results must be clear and convincing. *In re Lohr* 137 USPQ 548. Evidence of unexpected results must be commensurate in scope with the subject matter claimed. *In re Linder* 173 USPQ 356.

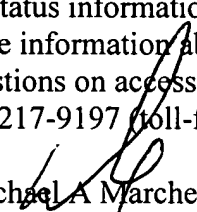
Art Unit: 1755

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael A. Marcheschi whose telephone number is (571) 272-1374. The examiner can normally be reached on M-F (8:00-5:30) First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on (571) 272-12331233. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

11/05
MM


Michael A Marcheschi
Primary Examiner
Art Unit 1755